

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-6 are currently pending. Claims 1 and 4, which are independent, are hereby amended. Claim 7 has been canceled without prejudice or disclaimer of subject matter. No new matter has been introduced. Support for this amendment is provided throughout the Specification, specifically on pages 9-14. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-6 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,311,011 to Kuroda (hereinafter, merely "Kuroda") in view of U.S. Patent No. 6,698,020 to Zigmond et al. (hereinafter, merely "Zigmond") and further in view of U.S. Publication No. 2003/0149988 to Ellis et al. (hereinafter, merely "Ellis").

Claim 1 recites, *inter alia*:

"A recording system for recording and/or reserving a broadcast program, comprising:

...user information management means for storing user information about each requesting origin, wherein a recording substitution means obtains advertising information appropriate for

a user attribute of the requesting origin via said connection means and inserting said information in a recorded program,

wherein said storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program.” (emphasis added)

As understood by Applicants, Kuroda relates to a device recorder for recording and playing data streams of audio, video and related information, as well as a device for displaying an Electronic Program Guide (EPG).

As understood by Applicants, Zigmond relates to displaying advertisements to viewers of a video programming feed at a household level.

As understood by Applicants, Ellis relates to interactive television program guide systems that allow users to record programs and program guide data on a media server.

Applicants respectfully submit that Kuroda, Zigmond and Ellis, taken alone or in combination, fail to teach or suggest the features of claim 1. Specifically, Applicants submit that there is no teaching or suggestion of a recording system for recording and/or reserving a broadcast program wherein said storage means permanently stores self-diagnostic data relating to content recording and reproducing sequences corresponding to expansion and compression of the original recorded program, as recited in claim 1.

Furthermore, Applicants submit that not only does Kuroda, Zigmond and Ellis, taken alone or in combination, fail to teach or suggest the claimed features, but the combination of Kuroda, Zigmond and Ellis is improper because it lacks motivation. Applicants submit that one skilled in the art would not be motivated to combine a device for recording video signals and for displaying an Electronic Program Guide, as disclosed in Kuroda, with displaying advertisements to viewers of a video programming feed at a household level, as disclosed in Zigmond, and with an interactive television program guide systems that allow users to record

programs and program guide data on a media server, as disclosed in Ellis. Indeed, the recitation of “user information management means for storing user information about each requesting origin, wherein a recording substitution means obtains advertising information appropriate for a user attribute of the requesting origin via said connection means and inserting said information in a recorded program” does not provide a suggestion to combine Kuroda, Zigmond and Ellis.

Applicants respectfully submit that the combination of Kuroda, Zigmond and Ellis is the result of improper hindsight using Applicants' claimed invention as a blueprint. Applicants also respectfully submit that picking and choosing particular features from divergent patents is improper and such a combination may not be used as a basis of rejection.

For the above-stated reasons, Applicants submit that the combination of Kuroda, Zigmond and Ellis is improper and the rejection should be withdrawn.

Therefore, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1, claim 4 is also believed to be patentable.

Therefore, Applicants submit that independent claims 1 and 4 are patentable.

III. DEPENDENT CLAIMS

The other claims are dependent from independent claims 1 and 4, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION


In the event the Examiner disagrees with any of the statements appearing above with respect to the disclosures in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate the portion, or portions, of the reference, or references, providing the basis for a contrary view.

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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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